

REMARKS

Six (6) new claims 51-56 have been submitted for entry in place of the twenty-five (25) rejected claims. If the Examiner deems any of the new claims to be unpatentable it is respectfully requested that the non-allowed new claims be entered for purposes of appeal so that the issues on appeal may be simplified and clarified.

The six new claims are readable on both the disclosure of applicant's copending parent application Serial No. 425,612 and the present disclosure and are patentable for the reasons stated below.

It is respectfully submitted that the Examiner's contention that the Lawrence disclosure is enabling under 35 U.S.C. 112 is contrary to White Consolidated Industries, Inc. v. Vega Servo-Control, Inc. (CAFC 1983) 218 USPQ 961.

The Lawrence "interpreter/formatter" purports to be a program and is disclosed in the reference patent merely as a box section 38 labeled "(TEXT CODE)". This cryptic description is far less enabling than the disclosure held deficient by the Court of Appeals in the White Consolidated case.

The following quotation from the White Consolidated decision makes clear the facts, issues and decision of the Court

of Appeals for the Federal Circuit:

"The '653 system also includes a universal input feature so that a single part program can be used to control a plurality of machine tools, thus eliminating the need to create a new part program for each tool. This feature is accomplished by writing the part program in a universal NC language (i.e., machine tool independent) and employing a language translator in the control system to translate the program into machine code to control the tool. Describing the language translator, the '653 patent reads:

The language TRANSLATOR used in the RUN mode may be a known translator capable of converting, in a single pass, a part program in programming language form into a part program in machine language form, as for example SPLIT (Sundstrand Program Language Internally Translated). In the CONVERSATIONAL mode, where each source or language part instruction is individually translated into machine language form, the TRANSLATOR program is modified by the additions shown in FIG. 12.

"At the time the application that resulted in the '653 patent was filed, SPLIT was a trade secret of Sunstrand, White's predecessor in interest, and was available only by purchase from Sunstrand.

"In holding the '653 patent invalid, Judge Cohn determined that (1) the language translator was an integral part of the '653 system; (2) SPLIT was the only single pass language known to work in the '653 system at the time and was considered by the investors to be the best mode; and (3) by failing to disclose SPLIT, the '653 patent failed of compliance with the enablement and best mode requirements of 35 U.S.C. 112.

"Issues

"(1) Whether Judge Cohn erred in holding the '653 patent invalid for noncompliance with the enablement requirement of 35 U.S.C. 112.

"Opinion

"(1) Enablement under 35 U.S.C. 112

"[1] 35 U.S.C. 112 requires that the invention be described 'in such full, clear, concise, and exact terms as to enable any person skilled in the art *** to make and use the same.' White does not claim that SPLIT was disclosed, but rather

that the specification contains an enabling disclosure notwithstanding its omission. White says the '653 patent calls for a known or standard single pass translator, as for example SPLIT, and specifies the characteristics of such a translator; that SPLIT was only an example; and that there were other known single pass translators interchangeable with SPLIT. White says because those other translators, e.g., ACTION and COMPACT, were known to those skilled in the art and available to them, the enablement requirement is satisfied.

"[2] We disagree. Though one may refer to an element of a claimed invention held as a trade secret by name only and yet satisfy 35 U.S.C. 112 if equivalent elements are known, and known to be equivalents, and available to those skilled in the art, In re Gebauer-Fuelnegg, et al., 50 USPQ 125, 121 F.2d 505 (CCPA 1941), there is insufficient evidence here from which to conclude that suitable substitutes for SPLIT were known and widely available. Testimony that ACTION and COMPACT were 'take-offs' of, i.e., patterned upon SPLIT, does not, for example, establish that those translators were known to be suitable substitutes for SPLIT. That other translators were available when the application was filed is unavailing where there is no basis in the record for finding that a person skilled in the art on reading the specification would know that another single pass processor would be suitable." (Emphasis added.)

The Court of Appeals thus held that where a named unavailable program is an "integral part" of the system the disclosure is enabling only if:

- (1) "suitable substitutes ... were known and widely available"; and
- (2) "a person skilled in the art on reading the specification would know that another ... processor would be suitable".

In the present case the Lawrence "interpreter/formatter" program is not even identified. The somewhat cryptic words "interpreter/formatter" appear to be a coined phrase which is not a term of art, is not defined, explained or disclosed in any dictionary, treatise, encyclopedia, patent or other publication, and is meaningless. It does not identify any particular program,

and does not suggest to one skilled in the art any widely available equivalent program which may be substituted for it.

Furthermore, although requested to do so, the Examiner has failed to show, either by affidavit or by reference, that software for performing the various required functions, operations and interactions of the "interpreter/formatter" was conventional or at least widely available at the time of filing of the respective patent applications of Lawrence et al. and applicant.

To rephrase the issue , a box labeled "Text Code" and identified only by a meaningless coined term having no basis in the literature cannot constitute "such full, clear, concise and exact terms as to enable any person skilled in the art *** to make and use" a program allegedly performing functions, operations and interactions so numerous and complex as to require several pages of specification merely to list them. The mere words "Text Code" may be "concise", but as a disclosure it is neither "full", nor "clear" nor "exact", and therefore is not "enabling".

The above arguments apply also to the functions of the Lawrence "editor" and "priority scheme" which purport to be "enabled" by an unidentified and undisclosed program stored in the same box section 38 of Lawrence's Fig. 5.

It is further respectfully submitted that the Examiner's statement on Page 6 of the action that "applicant has not rebutted the presumption of the operability of Lawrence et al. by

a preponderance of evidence" is erroneous. The Examiner appears to have overlooked that the paper entitled "THIRD AFFIDAVIT of MARK WADSWORTH" was filed in applicant's copending parent application and was incorporated by reference in the present application in the second paragraph of applicant's response to the Office Action mailed September 4, 1986 and that this affidavit averred:

"13. The Lawrence interpreter/formatter performs all of the display functions of a screen-oriented editor, and together with the rest of the mentioned functions constitutes an editor and only an editor.

"29. Third, the purported functions of the Lawrence editor are allegedly implemented by hardware and/or software neither of which is disclosed in the patent. *** "

A copy of this affidavit is enclosed for the Examiner's convenience.

The Examiner's reliance upon In re Sasse et al. 207 USPQ 107 is misplaced. In that the case the issue of enablement depended upon extrinsic facts susceptible of proof. There are no genuine issues of fact in the present case. That the Lawrence program is disclosed as a box labeled "Text Code" appears on the face of the patent and requires no affidavit to prove it. Such a disclosure is inadequate as a matter of law.

It is further respectfully submitted that the Examiner's objection to the specification and corresponding rejection of claims 26-50 on the alleged ground that "only one byte of code, not codes, can be stored in the received data register" are erroneous. The rejected claims do not recite that a plurality of

codes are stored in the data register simultaneously.

Furthermore, when interpreted in the light of the specification, as required by law, it is clear that the rejected claims are readable on the disclosure wherein a plurality of codes pass through the received data register serially.

Furthermore, of the seven (7) independent claims (26, 30, 36, 39, 43, 47 and 50) Claim 30 is the only claim which recites that "codes" are "stored" in the buffer. Claims 36, 39 and 43 do not even recite the plural term "codes."

Even if all the claims were like Claim 30 in this respect, misinterpretation of the claims, either by the applicant or by the Examiner, cannot affect the disclosure so as to render it non-enabling.

In any event, this issue is obviated by the newly submitted claims which recite only the buffer in the memory so as to read clearly on the original disclosure in applicant's parent application. Even assuming arguendo that the numerous Lawrence functions, operations and interactions relied upon by the Examiner are enabled, new claims 51-55 recite limitations which patentably distinguish them over the reference. For the Examiner's convenience several of these limitations which appear in Claim 51 are underlined in the copy of this claim reproduced below.

51. A computer system for the concurrent entry and processing of code, and comprising

a console having keys for entry of successive characters constituting said code,

a memory storing a buffer for holding said code, a code processor program consisting of a sequence of machine instructions, an interrupt service routine at a predetermined memory address, and a stack,

a central processing unit for executing said code processor program instructions and having an interrupt input, a program counter for storing the memory address of the next instruction to be executed by the central processing unit, and means immediately responsive to activation of the interrupt input to push the contents of the program counter onto said stack and to load into said program counter said memory address of the interrupt service routine,

means to cause the central processing unit to execute said code processor program instructions whereby the code processor program thereafter continuously maintains control of the central processing unit, except during interrupts, so as to process the code concurrently as the code is being entered into the system,

means responsive to striking one of said keys to activate said interrupt input whereby the contents of the program counter are pushed onto the stack and the memory address of the interrupt service routine is loaded into the program counter thereby immediately passing control of the central processing unit to the interrupt service routine, whereupon the code processor program is interrupted immediately upon completing the machine instruction which it was executing when the key was struck,

said interrupt service routine including an editor program for inserting into said buffer a character code corresponding to said struck key, and having a return instruction at the end thereof,

said central processing unit having means responsive to execution of said return instruction to pop from the stack into the program counter the memory address of the code processor program instruction immediately following the instruction interrupted by striking said key, whereby the code processor program continues processing said character codes at the location in the buffer where the code processor program was interrupted.

New Claim 52 is dependent upon Claim 51 and further recites that the code processor program is a compiler and further

defines the latter. Substantially all of the limitations of Claim 52 distinguish over the Lawrence reference, as explained in the enclosed copy of the third Wadsworth affidavit.

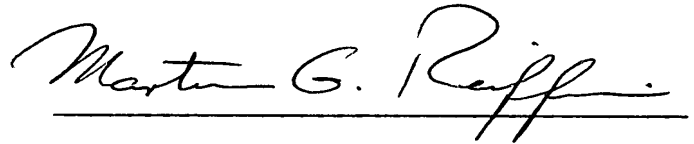
This affidavit appears to have been overlooked by the Examiner and should be considered and answered in the advisory action. The affidavit should make it clear that the Examiner has misapplied the terms "compiler", "parser", etc. to the Lawrence system. The meanings of terms are determined by the usage of those skilled in the art or may be defined by the applicant. It is too well-settled to require citation that it is the applicant, not the Examiner, who is the lexicographer.

New Claims 53-55 recite several of the limitations discussed above with respect to Claims 51 and 52.

New Claim 56 differs from the other new claims in that it lacks the above-noted limitations and therefore may be deemed by the Examiner to be readable upon Lawrence. Therefore this claim squarely raises the issue of whether the Lawrence reference contains an enabling disclosure of the functions, operations and interactions relied upon by the Examiner.

Favorable reconsideration in view of the above remarks is respectfully solicited.

Respectfully submitted,

A handwritten signature in dark ink, reading "Martin G. Reiffin". The signature is written in a cursive style with a horizontal line underneath it.

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